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**MAY 03 2006**

**OFFICE OF PETITIONS**

In re Application of  
Weichselbaum, Kufe  
Application No. 09/545,071  
Filed: April 7, 2000  
For: USE OF ANTI-VEGF ANTIBODY TO  
ENHANCE RADIATION IN CANCER THERAPY

:  
: CORRECTED  
: DECISION ON PETITION  
:  
:

This is a corrected decision on the petition under 37 CFR 1.137(b) filed September 3, 2004, supplemented February 4, 2005, and June 15, 2005, requesting revival of the above-identified application.

The petition is **denied**.

The decision on petition mailed September 23, 2004, that indicated revival is **vacated**.

BACKGROUND

This application became abandoned for failure to reply to the non final Office action of July 15, 2002, which set an extendable shortened statutory period for reply of 3 months. As no extensions of time were obtained under the provisions of 37 CFR 1.136(a), this application became abandoned at midnight on October 15, 2002. The date of abandonment is October 16, 2002. A Notice of Abandonment was mailed April 8, 2003.

A petition to revive the instant application under the provisions of 37 CFR 1.137(b) was filed September 3, 2004, and was granted in the decision of September 23, 2004 (now vacated as indicated above.)

On February 4, 2005, a communication was filed requesting withdrawal of the previously granted petition, which was dismissed in the decision of May 26, 2005, as lacking sufficient showing in the record to provide an adequate basis for withdrawal..

On June 15, 2005, applicant filed additional information which raises a question as to whether the abandonment and entire delay herein was unintentional. Accordingly, on the current record, the decision of September 23, 2004, cannot be permitted to stand and, as such, is **vacated**.

STATUTE AND REGULATION

35 U.S.C. § (2)(B)(2) provides, in part, that:

The Office-- may establish regulations, not inconsistent with law, which

(A) shall govern the conduct of proceedings in the Office;

Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable." Specifically, 35 U.S.C. § 41(a)(7) provides that the Commissioner shall charge:

On filing each petition for the revival of an unintentionally abandoned application for a patent or for the unintentionally delayed payment of the fee for issuing each patent, \$1500, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$500.

37 CFR 1.137(b) provides:

Unintentional. Where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to this paragraph. A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.

OPINION

Petitioner informs the USPTO that (1) the instant application was jointly owned by assignees University of Chicago (University), and Dana Farber Cancer Institute (DFCI), successors in title respectively to joint inventors Weichselbaum and Kufe, (2) the assignees jointly agreed and appointed, as usual, the University's technology transfer office (UTTO) to conduct the prosecution, which it actually performed, as usual, through outside patent counsel, (3) while UTTO believed that various patent counsel of the firm of Clark & Ebbing (C&E) were representing UTTO, the named inventors and assignees, UTTO was unaware that C&E had a possibly conflicting relationship with Ilex, a prospective licensee, (4) upon C&E's receipt of the Office action of July 15, 2002, (containing an anticipation rejection of all claims under 35

U.S.C. § 102(b)) it was sent to the various parties with a request for instructions for a response, but C&E did not itself otherwise provide any counsel or recommendations for replying to the action, (5) C&E subsequently notified UTTO (by e-mail) that Ilex no longer wished to pursue and maintain the application, (6) UTTO, apparently believing that C&E's failure to suggest any manner of amendment or argument for a reply to the Office action suggested that the rejection could not be overcome, agreed by way of the UTTO Project Manager in charge of, *inter alia*, this application to permit the application to become abandoned, such that (7) C&E did not prepare a reply and this application did become abandoned.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding balance thereof in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof; (2) the petition fee required by 37 CFR 1.17(m); (3) an adequate statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) in some instances, a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)).

This petition lacks item (3) above.

35 U.S.C. § 41(a)(7) applies to the situation of the above-identified application (i.e., to the revival of an abandoned application), however, it precludes the Director from reviving the above-identified application. This is because § 41(a)(7) only authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of \$500 or a fee of \$50 **would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional** as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), reprinted in 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application, as this application was, is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Commissioner to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where there is a question whether the delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989). Here in view of comments made in the petition, there is a question whether the entire delay was unintentional. Petitioner should note that the issue is not whether some of the delay was unintentional by any party; rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional. The USPTO requires that the entire period of the

delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner. . . could require applicants to act promptly after becoming aware of the abandonment").

It is further noted that 35 U.S.C. § 41(a)(7) does not require an affirmative finding that the delay was intentional, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unintentional. Cf. Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960)(35 U.S.C. § 133 does not require the Commissioner to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing); see also In re Application of G, supra (petition under 37 CFR 1.137(b) denied because the applicant failed to carry the burden of proof to establish that the delay was unintentional).

When the issue of revival is addressed, the focus must be on the rights of the parties as of the time of abandonment. See Kim v. Quigg, 781 F. Supp. 1280, 1284, 12 USPQ2d 1604, 1607 (E.D. Va 1989). Inspection of the document captioned "Combined Declaration and Power of Attorney" filed herein December 15, 2000, reveals that, pursuant to 37 CFR 1.31, the joint inventors appointed Messrs. Paul Clark, Reg. No. 30,162, Karen Elbing, Reg. No. 35,238; Kristina Baker-Brady, Reg. No. 39,109; Susan Michaud Reg. No. 42,885; Mary Scozzafava, Reg. No. 36,268, and James DeCamp, Reg. No. 43,580 "to prosecute this application and to transact all business in the Patent and Trademark Office." While inspection of USPTO assignment records confirms that University and DFCl are, jointly, the record assignees of the entire interest, there is no indication that the assignees ever exercised their right to take action in this application within the meaning of 37 CFR 3.71 and MPEP 324 to conduct the prosecution of this patent application to the exclusion of the inventive entity and appoint and revoke any power of attorney they chose. As such, the power of attorney came through, and resided with, the named inventors. Likewise, the showing of record is that both assignees mutually agreed that prosecution was to be conducted by UTTO. However as noted in MPEP 711.03(c)II(G):

Likewise, where the applicant permits a third party (whether a partial assignee, licensee, or other party) to control the prosecution of an application, the third party's decision whether or not to file a reply to avoid abandonment is binding on the applicant. See Winkler, 221 F. Supp. at 552, 138 USPQ at 667. Where an applicant enters an agreement with a third party for the third party to take control of the prosecution of an application, the applicant will be considered to have given the third party the right and authority to prosecute the application to avoid abandonment (or not prosecute), unless, by the express terms of the contract between applicant and the third party, the third party is conducting the prosecution of the application for the applicant solely in a fiduciary capacity. See Futures Technology Ltd. v. Quigg, 684 F. Supp. 430, 431, 7 USPQ2d 1588, 1589 (E.D. Va. 1988). Otherwise, the applicant will be considered to have given the third party unbridled discretion to prosecute (or not prosecute) the application to avoid abandonment, and will be bound by the actions or inactions of such third party.

Accordingly, the showing of record is that the joint assignees acquiesced to the power of attorney coming through the named inventors, and also acquiesced to UTTO having the unbridled discretion to prosecute (or not prosecute) the application to avoid abandonment.<sup>1</sup> The question under 37 CFR 1.137 is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. See MPEP 711.03(c)II(E). Here, UTTO had that right or authority. The showing of record is that the responsible person at UTTO made the conscious decision not to reply to the outstanding Office action. That is, UTTO intended that this application become abandoned, and this application did become abandoned as a result of that intent. Accordingly, this application was intentionally abandoned, and as such, revival is precluded. Likewise, the resultant delay in prosecution cannot be considered to be unintentional as it stems from a deliberative course of action, intentionally made, as opposed to delay resulting from an accident or inadvertent failure to reply. As noted in MPEP 711.03(c)II subsection (c)(1):

Where the applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). See *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989). An intentional course of action is not rendered unintentional when, upon reconsideration, the applicant changes his or her mind as to the course of action that should have been taken. See *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988).

That petitioner may now have been informed that a reply is possible to the outstanding Office action is simply a change in circumstance, but such an after the fact discovery does not undo the intentional abandonment or change the resultant delay into unintentional delay.

While petitioner's comments about the relationship between Ilex and C&G are noted the USPTO is not the proper forum for resolving a dispute between an applicant and his duly appointed registered practitioner regarding the failure to take a timely action in a proceeding before the USPTO. See *Ray v. Lehman*, 55 F.3d 606, 610, 34 USPQ2d 1786, 1789 (Fed. Cir. 1989). Thus if C&E counsel may have overlooked any obligation they may have had with respect to the named inventors as their duly appointed representatives before withholding a reply to the outstanding Office action, that is a matter among C&E counsel and Weichselbaum and Kufe. Furthermore, delay resulting from a failure in communication between a party and

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<sup>1</sup> An assignment of the entire right, title, and interest, passes both legal and equitable title. See *Wende v. Horine*, 191 F. 620, 621 (C.C.N.D. Ill. 1911). The named inventors, as the assignors of their entire interest, could not insist that the application be prosecuted by University or DFCI; the assignees were free to deal with this application as they willed. See *Garfield v. Western Electric Co.*, 298 F.659 (S.D.N.Y. 1924). Nevertheless, even though he assignees acquiesced to the interesting line(s) of authority herein, and even though the named inventors were directly represented by C&E, there is no showing that the named inventors instructed anyone at C&E, or requested their assignee, to reply to the outstanding Office action.

his duly appointed registered practitioner is a delay binding upon applicant. See In Re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988); Ray, id. The U.S. Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions, Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987).

While it appears that University and DFCI have now intervened for the purposes of attempting revival and have jointly revoked and appointed of a power of attorney, this does not change the nature of the abandonment herein and the nature of the resultant delay in this case. Petitioner is bound by the decisions, action(s), or inaction(s) of UTTO, which was the party having the right or authority to reply *vel non* for the assignees. See Winkler v. Ladd, 221 F.Supp 550, 552, 138 USPQ 666, 668 (D.D.C. 1963); Kim v. Quigg, supra. The inventors were likewise bound by the failure of their freely selected representatives to reply on their behalf. Petitioner is unable to overcome an intentional abandonment and any resultant delay attributable to the responsible party. Kim, supra; Winkler, supra.

#### DECISION

For the reasons given above, petitioner has failed to meet his burden of showing to the satisfaction of the Director that the entire delay in prosecution in this case is unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). Accordingly the decision of September 23, 2004 is **vacated**. The petition is **denied**. This application remains abandoned and will not be revived.

This decision may be regarded as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02

Inquiries related to this decision may be made to Petitions Examiner Brian Hearn at (571) 272-3217.



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